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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,219	04/26/2001	Lyle Theisen	P04822US0	8367

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 09/30/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/843,219

Applicant(s)

THEISEN, LYLE

Examin r

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of Amendment filed on June 30, 2003. Claims 33-52 are pending. Claim rejections under 35 U.S.C. § 103 (a) as indicated in the previous Office action dated March 27, 2003 are withdrawn in view of applicants amendments. New rejections are made.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36, 39, and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohno et al. (US 5628934) ("Ohno").

Ohno discloses an emulsified foundation comprising zinc oxide and zirconium oxide composite possessing photochromic properties, water, preservative, and iron oxide, which is viewed as a "fixed dye". See col. 21, Example 7. The reference teaches that the ingredients are dispersed in the mixture. See col. 21, lines 21 – 34. The reference also teaches that the color changes when irradiated with light and returns to its original color, indicating that the invention is a reversible photochromic composition. See col. 1, lines 18 – 24. While the reference does not mention the stable property of the composition, examiner takes the position that the recited stability in claim 42 is an inherent property of the prior art composition, since the composition meets every limitation of the claim 36.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohno as applied to claims 36, 39, and 42 as above.

Ohno reference teaches using 1-60 % of the photochromic color pigments. See col. 3, lines 4 – 9. The reference also teaches foundation formulations comprising up to 20 % of photochromic titanium oxide, up to 20 % of ordinary titanium oxide; paraben; and 2 % of iron oxide. See claims 37 and 38. The reference teaches using ordinary pigments, UV absorbers (light stabilizers), preservatives, water, and thickeners to blend with the composition in col. 7, lines 3 – 39.

Generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. See MPEP § 2144.05. Since the general conditions of the instant claims are disclosed in Ohno, examiner views that one having ordinary skill in the art would have discovered the optimum or workable ranges by routine experimentation. It would have been obvious to a routineer to modify the concentration of coloring agents to change the degree of intensity of color or change of color.

2. Claims 33, 35, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohno as applied to claims 36-39, 42 above, and further in view of Motion et al. (US 5656668) ("Motion").

Ohno fails to teach the pH of the composition.

Motion teaches topical compositions having pH in the range of 5.8- 7.5. See Examples 3-5.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have adjusted pH of the composition of Ohno as motivated by Motion to the pH level that is suitable for topical use. For claim 35, the recited composition of claim 33 would have been an obvious variation of the combined references, thus, the stability of the composition would have been an obvious property present in the composition.

3. Claims 34 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohno as applied to claims 33, 35-40, and 42 above, and further in view of Akashi et al. (US 5166345) ("Akashi").

Ohno, mentioned above, fails to teach photochromic composition comprising a benzene derivative and a binder.

Akashi teaches water-soluble photochromic polymers having a benzyl group. See col. 1, line 45– col. 2, line 24; col. 3, line 36 – col. 8, line 68. The reference teaches that the polymer particles are useful in cosmetic compositions. See col. 10, lines 28 – 43. The reference teaches adding a binder in formulating a photochromic composition. See Example 29. The reference teaches that the invention is durable and exhibits high color density, stable against heat and solvent, and has a good reversibility of the color. See col. 2, lines 26 – 38.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Ohno by substituting the photochromic pigments with the photochromic polymers of Akashi, as motivated by the reference, because of the expectation of successfully producing a cosmetic composition which is stable, exhibits good color density and reversibility of the color.

4. Claims 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohno in view of Coates et al.

Ohno, discussed above, fails to teach thermochromic composition.

Coates teaches the thermochromic cholesterol liquid crystalline phases useful in cosmetics in general. See abstract; col. 10, lines 4 – 51; Example 7. Azobenzenes or benzyldeneanilines are preferred components in the liquid crystal phase. See col. 9, lines 10 – 27.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Ohno by adding the thermochromic cholesteric liquid crystalline phases as motivated by Coates because of an expectation to successfully producing a cosmetic composition with both photochromic and thermochromic properties and thus enhancing the overall color change effects of the composition.

5. Claims 43, 45, and 46, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohno and Coates as applied to claims 47-50 above, and further in view of Motion.

Ohno and Coates fail to teach the pH of the composition.

Motion teaches topical compositions having pH in the range of 5.8- 7.5. See Examples 3-5.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have adjusted pH of the composition of the combined references as motivated by Motion to the pH level that is suitable for topical use. For claim 45, the recited composition of claim 43 would have been an obvious variation of the combined references, thus, the stability of the composition would have been an obvious property present in the composition.

6. Claims 44 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohno and Coates as applied to claims 43, 45- 51 above, and further in view of Akashi et al. (US 5166345) ("Akashi").

Ohno, Coates, and Motion fail to teach photochromic composition with a benzene derivative and a binder.

Akashi teaches water-soluble photochromic polymers having a benzyl group. See col. 1, line 45– col. 2, line 24; col. 3, line 36 – col. 8, line 68. The reference teaches that the polymer particles are useful in cosmetic compositions. See col. 10, lines 28 – 43. The reference teaches adding a binder in formulating a photochromic

composition. See Example 29. The reference teaches that the invention is durable and exhibits high color density, stable against heat and solvent, and has a good reversibility of the color. See col. 2, lines 26 – 38.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by substituting the photochromic pigments with the photochromic polymers as motivated by Akashi because of an expectation of successfully producing a cosmetic composition with stable property, high color density and good reversibility of the color, without the interference with the thermochromic properties of the composition.

Response to Arguments

Applicant's arguments with respect to claims 33-52 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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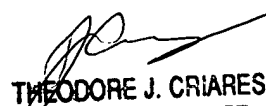
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner


THEODORE J. CRIARES
PRIMARY EXAMINER
GROUP 1200/600